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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,012	03/19/2004	James R. Hansen	11333-006002	7791
26161	7590	01/24/2007	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			VU, THONG H	
		ART UNIT	PAPER NUMBER	
		2616		

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/805,012	HANSEN, JAMES R.	
	Examiner Thong H. Vu	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-58 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/04;8/04;9/04;11/04;12/04;2/05. 1/13/05</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-58 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-58 are rejected on the ground of nonstatutory double patenting over claims 1-59 of U. S. Patent No. 6,757,714 B1 ('714) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

('714) 1. A method performed by a device associated with an apparatus to report a state of the apparatus to a remote computer that cannot directly address the device, the method comprising: detecting the state of the apparatus, wherein	(Application) 1. A computer-implemented method for using a device embedded in an apparatus to report the state of the apparatus to a remote computer, comprising: detecting the state of the apparatus;
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detecting is performed by monitoring variables associated with the apparatus, the monitoring occurring independently of communications from the remote computer;	
generating a message that reports the state of the apparatus using a self-describing computer language, wherein generating is performed periodically or in response to a deviation in the state; and	generating an electronic mail message that reports the state of the apparatus using a self-describing computer language; and
sending the message to the remote computer; wherein the deviation is indicative of an error condition in the apparatus, and wherein the error condition comprises one or more variables that deviate from an acceptable value or a predetermined range of acceptable values.	sending the electronic mail message to the remote computer.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- .. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2,4-15,17-19,21-32,34-36,38-51,53-58 are rejected under 35

U.S.C. 102(e) as being anticipated by Gandhi et al [Gandhi 7,085,814 B1].

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3. As per claim 1, Gandhi discloses A computer-implemented method for using a device embedded in an apparatus (i.e.: controller) to report the state of the apparatus to a remote computer, comprising:

detecting the state of the apparatus [Gandhi, detect when the new capabilities are available, col 43 lines 55-67];

generating an electronic mail message that reports the state of the apparatus using a self-describing computer language [Gandhi, network error sending event notification, col 27 line 35, XML scheme as a self-describing computer language, col 28 lines 36-57]; and

sending the electronic mail message to the remote computer [Gandhi, remote control 1051, Fig 27, col 37 lines 35-53].

4. As per claim 2 Gandhi discloses the state is indicative of an error condition in the apparatus [Gandhi, error and state table, col 27 lines 35-50].

5. As per claim 4 Gandhi discloses detecting the state comprises receiving the state from the apparatus [Gandhi, receives error, col 27 lines 35-50]

6. As per claim 5 Gandhi discloses detecting the state comprises retrieving the state periodically from the apparatus [Gandhi, timeout: second 6000, col 27 line 67].

7. As per claim 6 Gandhi discloses detecting the state comprises:

obtaining an identifier for the apparatus, the identifier relating to the state of the apparatus [Gandhi, the event subscription with new ID, col 84 lines 39-45]; and reading the state from the apparatus using the identifier [Gandhi, the control point will get a new subscription identifier, col 84 lines 39-45].

8. As per claim 7 Gandhi discloses determining if the state of the apparatus has changed [Gandhi, determine if it is an event notification, col 22 lines 45];

wherein the electronic mail message is generated if the state of the apparatus has changed [Gandhi, GENA defines the format of HTTP message, col 2 lines 45-50].

9. As per claim 8, Gandhi discloses determining comprises comparing the state received from the apparatus to a previous state of the apparatus [Gandhi, previous notification, col 27 lines 35-50] .

10. As per claim 9, Gandhi discloses the self-describing computer language comprises extensible Markup Language (XML) [Gandhi, XML, col 28 lines 36-57].

11. As per claim 10 Gandhi discloses the electronic mail message is generated using a predefined template, the electronic mail message being generated by obtaining one or more variables relating to the apparatus; and inserting the one or more variables into the template [Gandhi, the UPnP template, col 86 lines 30-43].

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12. As per claim 11 Gandhi discloses the state of the apparatus is included as part of a body of the electronic mail message [Gandhi, the body of message, col 19 lines 20-25].

13. As per claim 12, Gandhi discloses the state of the embedded device is included as part of an attachment to the electronic mail message as inherent feature of event notification.

14. As per claim 13 Gandhi discloses A computer-implemented method for Obtaining a state of an apparatus from a device embedded in the apparatus, comprising:

receiving an electronic mail message that reports the state of the apparatus using a self-describing Computer language [Gandhi, network error sending event notification, col 27 line 35; XML, col 28 lines 36-57]; and

extracting the state of the apparatus from the electronic mail message [Gandhi, detect when the new capabilities are available, col 43 lines 55-67].

15. As per claim 18 Gandhi discloses A computer program stored on a computer-readable medium for reporting the state of an apparatus to a remote computer, the computer program comprising instructions that cause an embedded device in the apparatus to:

detect the state of the apparatus [Gandhi, detect when the new capabilities are available, col 43 lines 55-67];

generate an electronic mail message that reports the state of the apparatus using a self-describing computer language [Gandhi, network error sending event notification, col 27 line 35, XML scheme as a self-describing computer language, col 28 lines 36-57]; and

send the electronic mail message to the remote computer [Gandhi, remote control 1051, Fig 27, col 37 lines 35-53].

16. As per claim 30 Gandhi discloses A computer program stored on a computer-readable medium for obtaining a state of an apparatus from all device embedded in the apparatus/ the computer program comprising instructions that cause a processor to:

receive an electronic mail message that reports the state of the apparatus using a self-describing computer language [Gandhi, network error sending event notification, col 27 line 35, XML scheme as a self-describing computer language, col 28 lines 36-57]; and

extract the state of the apparatus from the electronic mail message [Gandhi, remote control 1051, Fig 27, col 37 lines 35-53].

17. As per claim 35 Gandhi discloses A device embedded in an apparatus for reporting the state of an apparatus to a remote computer, the embedded device comprising circuitry which:

detects the state of the apparatus [Gandhi, detect when the new capabilities are available, col 43 lines 55-67];

generates an electronic mail message that reports the state of the apparatus using a self-describing computer language [Gandhi, network error sending event notification, col 27 line 35, XML scheme as a self-describing computer language, col 28 lines 36-57]; and

sends the electronic mail message to the remote computer [Gandhi, remote control 1051, Fig 27, col 37 lines 35-53].

18. As per claim 49 Gandhi discloses A first apparatus for obtaining a state of a second apparatus from a device embedded in the second apparatus, the first apparatus comprising Circuitry which receives an electronic mail message that reports the state of the second apparatus using a self-describing Computer language [Gandhi, network error sending event notification, col 27 line 35, XML scheme as a self-describing computer language, col 28 lines 36-57]; and

extracts the state of the second apparatus from the electronic mail message [Gandhi, detect when the new capabilities are available, col 43 lines 55-67].

19. As per claim 56 Gandhi discloses A system comprising:
a first device comprising circuitry which generates an electronic mail message reporting a state of an apparatus using a self-describing computer language [Gandhi, network error sending event notification, col 27 line 35, XML scheme as a self-describing computer language, col 28 lines 36-57], and a second device, in communication with the first device, the second device comprising circuitry which

receives the electronic mail message from the first device [Gandhi, remote control 1051, Fig 27, col 37 lines 35-53]

20. Claims 14-15,17,19,21-29,31-32,34,36,38-48,50-51,53-55,57,58 contain the identical limitations set forth in claims 2,4-12. Therefore claims 14-15,17,19,21-29,31-32,34,36, 38-48,50-51,53-55,57,58 are rejected for the same rationale set forth in claims 2,4-12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,16,20,33,37,52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gandhi et al [Gandhi 7,085,814 B1] in view of Bisbee et al [Bisbee 2004/0093493 A1].

21. ✓ As per claims 3,16,20,33,37,52 Gandhi discloses the error condition [Gandhi, network error sending event notification, col 27 line 35],

However Gandhi does not detail a variable that **deviates** from an acceptable value or a predetermined range of acceptable values

In the same endeavor, Bisbee taught system and method for a Certificate Status service including validity period overlaps the TCU's current date and time, checking that the local date and time falls within an allowable deviation from the TCU's current date and time, and retrieving status of the authentication certificate from the CSS [Bisbee, claim 28]

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the allowable deviation from a predetermined range such as time and date as taught by Bisbee into the Gandhi's apparatus in order to utilize the error condition.

Doing so would provide a verifiable chain of evident and security of the creation, maintenance, transfer, retrieval and destruction of electronic documents [Bisbee, 0002]

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3333. The examiner can normally be reached on Monday-Thursday from 6:00AM- 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Failed Lynn*, can be reached at (571) 272-2092. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thong Vu
Primary Examiner
Art Unit 2616



THONG VU
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100